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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,281	07/25/2006	Fumihiro Hayashi	073759-0017	4907
20277 7590 01/02/2009 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
VO, HAI				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,281

**Applicant(s)**

HAYASHI ET AL.

**Examiner**

Hai Vo

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. All of the art rejections are maintained. In addition, new ground of rejection is made in view of newly discovered to Chang et al (US 7,049,380).
2. The provisional obviousness-type double patenting rejections over Application No. 10/551,459 and Application No. 10/586,341 separately are maintained.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-32 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 2004108322. Okuda et al (US 2006/0141159) will be relied on as an equivalent form of WO 2004108322. Okuda teaches an anisotropic electrically conductive film

comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (figure 3f). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraph 83). Okuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Okuda meets all the structural limitations as required by the claims. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. An expanded porous PTFE film has a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (figure 3f). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Okuda does not specially teach the expanded porous PTFE compressed at a compression ratio of 1.2 to 3.0 in the thickness direction. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Okuda is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Okuda.

6. The art rejections over Okuda have been maintained for the following reasons. Applicants contend that "the products are different from each other when a comparison of the product processes reveals the distinctions." The argument is

nothing more than a conclusionary statement unsupported by any evidence of record. The argument would be found more persuasive if Applicants can show that the residual strain and elastic modulus could not be inherently present based on the process disclosed in Okuda by experimental data. Applicants further aver that the microstructure of the Okuda film retained after perforation whereas in the present invention, the microstructure of the film is changed because of the reduction in thickness and porosity resulted from cooling and compressing. The arguments are not found convincing for patentability because they are not commensurate in scope with the claims. Nothing in the claims is specific about the special features associated with the change in the film microstructure to show the distinctions.

With respect to the limitation "the expanded porous PTFE is compressed at a compression ratio of 1.2 to 3.0 in the thickness direction", it is reminded that while the product claims can include the process steps of making a microstructure film, the product-by-process limitations are not required to be searched since only the result of the process in the article is limiting, not the steps themselves. Accordingly, Okuda anticipates or strongly suggests the claimed subject matter.

7. Claims 25-32 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2004-265844. Masuda et al (US 2006/0251871) will be relied on as an equivalent form of JP 2004-265844. Matsuda teaches an anisotropic electrically conductive film comprising an

expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (figure 7). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraphs 9, 11 and 52). Matsuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Matsuda meets all the structural limitations as required by the claims. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. An expanded porous PTFE film has a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes. The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Matsuda does not specially teach the expanded porous PTFE compressed at a compression ratio of 1.2 to 3.0 in the thickness direction. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Matsuda is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Matsuda.

8. The art rejections over Matsuda have been maintained for the following reasons. Applicants contend that "the products are different from each other when a comparison of the product processes reveals the distinctions." The argument is



nothing more than a conclusionary statement unsupported by any evidence of record. The argument would be found more persuasive if Applicants can show that the residual strain and elastic modulus could not be inherently present based on the process disclosed in Matsuda by experimental data. Applicants further aver that the microstructure of the Matsuda film retained or slightly changed after the pores are filled with the conductive metal whereas in the present invention, the microstructure of the film is changed because of the reduction in thickness and porosity resulted from cooling and compressing. The arguments are not found convincing for patentability because they are not commensurate in scope with the claims. Nothing in the claims is specific about the special features associated with the change in the film microstructure to show the distinctions.

With respect to the limitation "the expanded porous PTFE is compressed at a compression ratio of 1.2 to 3.0 in the thickness direction", it is reminded that while the product claims can include the process steps of making a microstructure film, the product-by-process limitations are not required to be searched since only the result of the process in the article is limiting, not the steps themselves. Accordingly, Matsuda anticipates or strongly suggests the claimed subject matter.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application

claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 25-32 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/551,459 (US 2006/0251871 to Matsuda et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '459 application teaches each and every limitation except a residual strain and elastic modulus. It appears that the '459 application meets all the structural limitations as required by the claims. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. An expanded porous PTFE film has a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes. The expanded porous PTFE has a microstructure

composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The '459 application does not specially teach the expanded porous PTFE compressed at a compression ratio of 1.2 to 3.0 in the thickness direction. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of the '459 application is identical to or only slightly different than the claimed article prepared by method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227

USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the '459 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Applicants have reiterated positions taken with respect to the double patenting rejections over the '459 application, the examiner's comments set forth in the rejections over Matsuda are equally pertinent in the support of these rejections as well.
12. Claims 25-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/586,341 (US 2007/0160810 to Hayashi et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '341 application teaches each and every limitation except a residual strain and elastic modulus set out in the claims. It appears that the '341 application meets all the structural limitations as required by the claims. Therefore, it is not seen that the residual strain and elastic modulus

could have been outside the claimed ranges as like material has like property.

An expanded porous PTFE film has a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes. The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The '341 application does not specially teach the expanded porous PTFE compressed at a compression ratio of 1.2 to 3.0 in the thickness direction. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Matsuda is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of

production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the '341 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Applicants have reiterated positions taken with respect to the double patenting rejections over the '341 application, the examiner's comments set forth in the rejections over Matsuda are equally pertinent in the support of these rejections as well.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/  
Primary Examiner, Art Unit 1794